

USSN: 09/990,186
Atty. Dkt. No.: 8325-0011.21
Client Dkt. No.: S11-US3

PATENT

CERTIFICATE OF MAILING PURSUANT TO 37 CFR § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on **February 17, 2004.**

2/17/04
Date

Michelle Hobson
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

LIU et al.

Serial No.: 09/990,186

Filing Date: November 20, 2001

Title: POSITION DEPENDENT RECOGNITION OF
GNN NUCLEOTIDE TRIPLETS BY ZINC
FINGERS

Examiner: A. Chakrabarti

Group Art Unit: 1634

Confirmation No.: 1799

Customer No.: 20855

REQUEST TO CORRECT INVENTORSHIP UNDER 37 C.F.R. 1.48(a)(1)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

This Petition is filed in order to correct the inventorship of the above-identified patent application under 37 CFR §1.48(a). The inventorship as originally named was incorrect due to an error made without deceptive intent.


Applicant respectfully requests that Edward REBAR and Andrew C. JAMIESON be added as coinventors to the application.

Accompanying this Petition is a Statement from Persons to be Added as Inventors Pursuant to 37 C.F.R. 1.48(a)(2), signed by Edward REBAR and Andrew C. JAMIESON, a Consent of Assignee for Correction of Inventorship Under 37 CFR §1.48(a), a Certificate Under 37 CFR §3.73(b), a Substitute Declaration and Power of Attorney signed by each of the inventors, and the required fee pursuant to 37 CFR §1.17(h).

The Commissioner is respectfully requested to act favorably on this Petition and amend inventorship as specified above. In addition, the Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.16 and 1.17 that may be required by this paper, or to credit any overpayment, to Deposit Account no. 18-1648.

Respectfully submitted,

Date: February 17, 2004

By: 
Dahna S. Pasternak
Registration No. 41,411

ROBINS & PASTERNAK LLP
1731 Embarcadero Road, Suite 230
Palo Alto, CA 94303
Tel.: (650) 493-3400
Fax: (650) 493-3440



Atty Dkt No. 8325-0011.21(S11-US3)

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2/17/04

Date by

Michelle Hobson

Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Qiang LIU

Application No.: 09/990,186

Filed: November 20, 2001

For: **POSITION DEPENDENT
RECOGNITION OF GNN NUCLEOTIDE
TRIPLETS BY ZINC FINGERS**

Examiner: A.K. Chakrabarti

Group Art Unit: 1634

Confirmation No.: 1799

**STATEMENT FROM PERSONS
TO BE ADDED AS INVENTORS
UNDER 37 C.F.R. 1.48(a)(2)**

P.O. Box 1450
Commissioner for Patents
Alexandria, VA 22313

Sir:

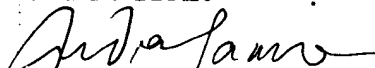
We, Edward REBAR and Andrew C. JAMIESON, hereby verify that the error in inventorship on the above-identified application occurred without deceptive intent.

We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 1/16/04

Date: 1/16/04


Edward REBAR


Andrew C. JAMIESON

SUBSTITUTE DECLARATION FOR UTILITY PATENT APPLICATION

AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if more than one name is listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: POSITION DEPENDENT RECOGNITION OF GNN NUCLEOTIDE TRIPLETS BY ZINC FINGERS the specification of which

____ is attached hereto
X was filed on November 20, 2001

and assigned Serial No. 09/990,186 and amended on February 5, 2002 and February 10, 2003.

I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED TO ABOVE.

I acknowledge and understand that I am an individual who has a duty to disclose information which is material to the patentability of the claims of this application in accordance with Title 37, Code of Federal Regulations, §§ 1.56(a) and (b) which state:

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or

attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

I do not know and do not believe this invention was ever known or used in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to said application. This invention was not in public use or on sale in the United States of America more than one year prior to this application. This invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on any application filed by me or my legal representatives or assigns more than six months prior to this application.

I hereby claim priority benefits under Title 35, United States Code § 119(e)(1) of any United States provisional application(s) for patent as indicated below and have also identified below any application for patent on this invention having a filing date before that of the application for patent on which priority is claimed:

<u>Application No.</u>	<u>Date of Filing (day/month/year)</u>	<u>Priority Claimed</u>
60/126,238	March 24, 1999	Yes <u>X</u> No
60/126,239	March 24, 1999	Yes <u>X</u> No
60/146,595	July 30, 1999	Yes <u>X</u> No
60/146,615	July 30, 1999	Yes <u>X</u> No

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below, and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) and (b) set forth above which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Serial No.: 09/535,088
Filing Date: March 23, 2000
Status (patented, pending, abandoned): abandoned

Application Serial No.: 09/716,637
Filing Date: November 20, 2000
Status (patented, pending, abandoned): pending

As to the subject matter of this application which is common to said earlier application, I do not know and do not believe that the same was ever known or used in the United States of America before my or our invention thereof or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to said earlier application, or in public use or on sale in the United States of America more than one year prior to said earlier application; that said common subject matter has not been patented or made the subject of an inventor's certificate issued before the date of said earlier application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to said earlier application; and that the earliest application(s) for patent or inventor's certificate on said invention filed by me or my legal representatives or assigns in any country foreign to the United States of America is identified herein, as well as all other such applications (if any) filed more than twelve months prior to the filing date of this application.

As to the subject matter of this application which is not common to said earlier application, I do not know and do not believe that the same was ever known or used in the United States of America before my or our invention thereof or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the date of this application, or in public use or on sale in the United States of America more than one year prior to the date of this application, and that said subject matter has not been patented or made the subject of an inventor's certificate issued in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months prior to the date of this application, and that the earliest application(s) for patent or inventor's certificate on said subject matter filed by me or my legal representatives or assigns in any country foreign to the United States of America is identified herein, as well as all other such application(s) (if any) filed more than twelve months prior to the filing date of this application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signature: 

Date

1/12/04

Full Name of Inventor: Qiang LIU

Citizenship: US

Residence: Foster City, California

Post Office Address: 55 Williams Lane, Foster City, CA 94404

Signature: 

Date

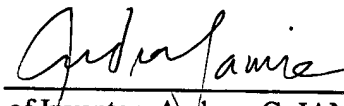
1/16/04

Full Name of Inventor: Edward REBAR

Citizenship: US

Residence: El Cerrito, California

Post Office Address: 1609 Roger Court, El Cerrito, CA 94530

Signature: 

Date

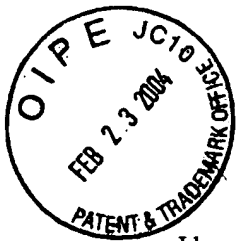
1/16/04

Full Name of Inventor: Andrew C. JAMIESON

Citizenship: United Kingdom

Residence: San Francisco, California

Post Office Address: 2528 Sutter Street, San Francisco, CA 94115



Atty Dkt No. 8325-0011.21(S11-US3)

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on 2/17/04 by Michelle Hobson
Date Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Qiang LIU

Application No.: 09/990,186

Filed: November 20, 2001

For: **POSITION DEPENDENT
RECOGNITION OF GNN NUCLEOTIDE
TRIPLETS BY ZINC FINGERS**

Examiner: A.K. Chakrabarti

Group Art Unit: 1634

Confirmation No.: 1799

**CONSENT OF ASSIGNEE TO
CORRECT INVENTORSHIP
UNDER 37 C.F.R. 1.48(a)**

P.O. Box 1450
Commissioner for Patents
Alexandria, VA 22313

Sir:

Sangamo BioSciences, Inc., the owner of the entire right, title and interest in and to the above-identified application, by virtue of assignments from the inventors of the patent application identified above (copies attached), and hereby consents to the request to correct inventorship of the above-identified application to add Edward REBAR and Andrew C. JAMIESON as an inventors.

Sangamo BioSciences, Inc.

Date: 1-22-04

By:

Peter Blufford
Name: Peter Blufford
Title: Vice President, Corporate Development

COPY

Atty Dkt No. 8325-0011.21
S11-US3

ASSIGNMENT

JOINT

THIS ASSIGNMENT, by Edward REBAR and Andrew C. JAMIESON (hereinafter referred to as the assignors), residing at El Cerrito, CA and San Francisco, CA respectively, witnesseth:

WHEREAS, the said assignors have invented certain new and useful improvements in POSITION DEPENDENT RECOGNITION OF GNN NUCLEOTIDE TRIPLETS BY ZINC FINGERS set forth in an application for Letters Patent of the United States, bearing Serial No. 09/990,186 and filed on November 20, 2001; and

WHEREAS, Sangamo BioSciences, Inc., a corporation duly organized under and pursuant to the laws of Delaware, and having its principal place of business at Point Richmond Tech Center, 501 Canal Blvd., Suite A100, Richmond, CA 94804 (hereinafter referred to as the assignee) is desirous of acquiring the entire right, title and interest in and to said inventions and said application for Letters Patent of the United States, and in and to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon:


NOW THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient considerations, the receipt of which is hereby acknowledged, the said assignors have sold, assigned, transferred and set over, and by these presents do sell, assign, transfer and set over, unto the assignee, its successors, legal representatives and assigns, the entire right, title and interest in and to the above-mentioned inventions, application for Letters Patent, and any and all Letters Patent or Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations, and continuations-in-part of said application, or reissues or extensions of said Letters Patent or Patents, and all rights under the International Union for the Protection of Industrial Property, the same to be held and enjoyed by the said assignee, for its own use and behoof and the use and behoof of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted, as fully and entirely as the same would have been held and enjoyed by the assignors, had this sale and assignment not been made.


AND for the same consideration, the said assignors hereby covenant and agree to and with the said assignee, its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, the said assignors are the sole and lawful owners of the entire right, title and interest in and

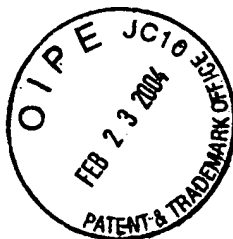
to the said inventions and the application for Letters Patent above-mentioned, and that the same are unencumbered and that the said assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND for the same consideration, the said assignors hereby covenant and agree to and with the said assignee, its successors, legal representatives and assigns, that the said assignors will, whenever counsel of the said assignee, or the counsel of its successors, legal representatives and assigns, shall advise that any proceeding in connection with said inventions, or said application for Letters Patent, or any proceeding in connection with Letters Patent for said inventions in any country, including interference proceedings, is lawful and desirable, or that any division, continuation or continuation-in-part of any application for Letters Patent or any reissue or extension of any Letters Patent, to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of Letters Patent for said inventions, without charge to said assignee, its successors, legal representatives and assigns, but at the cost and expense of the said assignee, its successors, legal representatives and assigns.

AND the said assignors hereby request the Commissioner of Patents to issue said Letters Patent of the United States to the said assignee as the assignee of said inventions and the Letters Patent to be issued thereon for the sole use and behoof of the said assignee, its successors, legal representatives and assigns.

Date 1/16/04 Name of Inventor 
Edward REBAR

Date 1/16/04 Name of Inventor 
Andrew C. JAMIESON



Atty Dkt No. 8325-0011.21(S11-US3)

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2/17/04 Michelle Hobson
Date by Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Qiang LIU

Application No.: 09/990,186

Filed: November 20, 2001

For: **POSITION DEPENDENT
RECOGNITION OF GNN NUCLEOTIDE
TRIPLETS BY ZINC FINGERS**

Examiner: A.K. Chakrabarti

Group Art Unit: 1634

Confirmation No.: 1799

**CERTIFICATE UNDER 37 C.F.R.
3.73(b)**

P.O. Box 1450
Commissioner for Patents
Alexandria, VA 22313

Sir:

SANGAMO BIOSCIENCES, INC., a corporation, certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of assignments from the inventors of the patent application identified above. Copies of the assignments are attached.

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 1-22-04

SANGAMO BIOSCIENCES, INC.

Name: Peter Bluford

Title: Vice President, Corporate Development

COPY

Atty Dkt No. 8325-0011.21
S11-US3

ASSIGNMENT

JOINT

THIS ASSIGNMENT, by Edward REBAR and Andrew C. JAMIESON (hereinafter referred to as the assignors), residing at El Cerrito, CA and San Francisco, CA respectively, witnesseth:

WHEREAS, the said assignors have invented certain new and useful improvements in POSITION DEPENDENT RECOGNITION OF GNN NUCLEOTIDE TRIPLETS BY ZINC FINGERS set forth in an application for Letters Patent of the United States, bearing Serial No. 09/990,186 and filed on November 20, 2001; and

WHEREAS, Sangamo BioSciences, Inc., a corporation duly organized under and pursuant to the laws of Delaware, and having its principal place of business at Point Richmond Tech Center, 501 Canal Blvd., Suite A100, Richmond, CA 94804 (hereinafter referred to as the assignee) is desirous of acquiring the entire right, title and interest in and to said inventions and said application for Letters Patent of the United States, and in and to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon:


NOW THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient considerations, the receipt of which is hereby acknowledged, the said assignors have sold, assigned, transferred and set over, and by these presents do sell, assign, transfer and set over, unto the assignee, its successors, legal representatives and assigns, the entire right, title and interest in and to the above-mentioned inventions, application for Letters Patent, and any and all Letters Patent or Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations, and continuations-in-part of said application, or reissues or extensions of said Letters Patent or Patents, and all rights under the International Union for the Protection of Industrial Property, the same to be held and enjoyed by the said assignee, for its own use and behoof and the use and behoof of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted, as fully and entirely as the same would have been held and enjoyed by the assignors, had this sale and assignment not been made.


AND for the same consideration, the said assignors hereby covenant and agree to and with the said assignee, its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, the said assignors are the sole and lawful owners of the entire right, title and interest in and

to the said inventions and the application for Letters Patent above-mentioned, and that the same are unencumbered and that the said assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND for the same consideration, the said assignors hereby covenant and agree to and with the said assignee, its successors, legal representatives and assigns, that the said assignors will, whenever counsel of the said assignee, or the counsel of its successors, legal representatives and assigns, shall advise that any proceeding in connection with said inventions, or said application for Letters Patent, or any proceeding in connection with Letters Patent for said inventions in any country, including interference proceedings, is lawful and desirable, or that any division, continuation or continuation-in-part of any application for Letters Patent or any reissue or extension of any Letters Patent, to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of Letters Patent for said inventions, without charge to said assignee, its successors, legal representatives and assigns, but at the cost and expense of the said assignee, its successors, legal representatives and assigns.

AND the said assignors hereby request the Commissioner of Patents to issue said Letters Patent of the United States to the said assignee as the assignee of said inventions and the Letters Patent to be issued thereon for the sole use and behoof of the said assignee, its successors, legal representatives and assigns.

Date 1/16/04 Name of Inventor 
Edward REBAR

Date 1/16/04 Name of Inventor 
Andrew C. JAMIESON